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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/959,125	10/28/1997	YOSHIHIKO HIGUCHI	20111-0014	4244

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JOHN S. PRATT  
KILPATRICK STOCKTON LLP  
1100 PEACHTREE  
SUITE 2800  
ATLANTA, GA 30309

EXAMINER

ALEXANDER, LYLE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 07/16/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

VIF=23

# Office Action Summary

Application No.

08/959,125

Applicant(s)

HIGUCHI ET AL.

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-5, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 14-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

This office action is in response to the 6/11/02 decision of the petition to withdraw holding of abandonment. Applicants should also note new "claim 6" as presented in the 9/14/00 amendment has been renumbered under rule 1.312 as claim 15.

***Claim Rejections - 35 USC § 112***

Claims 2-5 and 14-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

New claim 15 contains the limitation "uniform distribution in the matrix" which does not appear to be supported by the original specification. Clarification can be achieved by pointing out the support for this amendment in the original specification.

Additionally, the claimed range of "more than about 30%" is not supported in the original specification. The specification on page 17 teaches a broad range of "5-80 wt%". The claimed range of more than 30% would encompass all concentration less than 5wt%. Clarification could be achieved on this issue by claiming a range of 5-30 wt%.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-5 and 14-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koyama et al., Terahima et al. or EP 162,302 (EP hereafter).

See the appropriate paragraph of paper 9.

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New claim 15 contains substantially identical limitations to claim 1 with the exception of claiming more than 30 wt% of the polymer bead. In light of the above 35 USC 112 issues, this limitation has been fully considered and is believed to read on the cited prior art. However, if Applicant were to clarify these issues, the Office notes EP teaches on page 2 lines 30+ indistinguishable polymer weight percentages. With respect to the remaining two references, the Office would reject the claims under 35 USC 103 and take the position the selection of the polymer concentration would have been obvious as optimization of a result effective variable (see In re Boesch 205 USPQ 215). The potential 35 USC 103 rejection could be overcome by a proper and timely filed 1.132 Declaration showing the claimed range give different/unexpected results from other similar ranges.

### ***Response to Arguments***

Applicant's arguments filed 9/14/00 have been fully considered but they are not persuasive.

Applicants state the claims define over Koyama et al. on the basis of the "not more than 30wt%" and the "uniform distribution". These two points are moot in light of the above 35 USC 112 issues. Even if the issues are resolved, as stated above, the Office would maintain the rejection under 35 USC 103 and take the position the selection of the polymer concentration would have been obvious as optimization of a result effective variable (see In re Boesch 205 USPQ 215).

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Applicants also state Koyama et al. fails to teach the light reflective particles being imbedded within individual polymer beads. The Office maintains the claimed "imbedding" is sufficiently broad to be read on the attachment taught by the prior art.

Applicants state Terahima et al. and EP teach multiple layers and cannot be read on the claimed "single reagent layer". The Office maintains both prior art references also teach a single reagent layer and have been properly read on the instant claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Lyle A Alexander  
Primary Examiner  
Art Unit 1743

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July 3, 2002